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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/603,601	06/26/2000	James D. Marks	30421/1G691-US2	3416
7590	02/09/2006		EXAMINER RIMELL, SAMUEL G	
Cheryl F Cohen Darby & Darby PC 805 Third Avenue New York, NY 10022			ART UNIT 2164	PAPER NUMBER

DATE MAILED: 02/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/603,601

Applicant(s)

MARKS, JAMES D.

Examiner

Sam Rimell

Art Unit

2164

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10, 12-14, 23-40 and 51 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12-14, 23-40 and 51 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


SAM RIMELL
PRIMARY EXAMINER

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

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The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-10, 12-14, 23-40 and 51 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1: Claim 1 has been amended to define “a first question that identifies a chosen expert” and “a second question that identifies a chosen expert”. It found that these limitations are new matter, as the original specification does not describe any embodiment by which the questions themselves identify the experts.

FIG. 2 in applicant's drawings does identify an embodiment where the user is provided a template that allows the user to specify a doctor, fill in a title and fill in a question. This is discussed in applicant's specification at page 10, lines 15-18. However, there is no suggestion in the specification that the question itself provides the identification of the first expert, which is what is currently claimed. Page 11, lines 16-19 discuss the concept that a question can be forwarded to experts either automatically or by a human operator, but there is no suggestion that the question itself dictates where the question gets forwarded. Accordingly, the claimed feature which specify that a question identifies a chosen expert is found to be new matter.

Claims 2-7: Depend on claim 1.

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Claim 8: The last paragraph of claim 8 has been amended to define a payment that represents a benefit provided by the user, and the payment “having a value that is related to the user’s consumption of the product or service”. The concept of having a payment that is related to consumption of a product or service is not disclosed or suggested in the original disclosure.

Page 22, last paragraph of the specification does discuss the concept of paying access fees on behalf of users or adjust insurance premiums. However, these payments or adjustments are based upon the user accessing the expert fora. They are not based on the user consuming any specific product or service independent of the network site, which is how the claim defines the product or service. Accordingly, this claimed feature referring to consumption of products or services is new matter.

Claim 9-10: Depend on claim 8.

Claim 12: Same basis of rejection as claim 1.

Claim 13-14: Depend on claim 12.

Claims 23-27: Depends on claim 8.

Claims 28-29: Same basis of rejection as claim 1.

Claims 30-34: Depend on claim 29.

Claim 35: Same basis of rejection as claim 8.

Claims 36-40 and 51: Depend on claim 35.

Remarks

Applicant’s arguments are moot in light of the new grounds of rejection. This action follows the filing of an RCE request and is made non-final.

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Although no prior art is applied, no allowability is indicated due to the presence of new matter.

Any inquiry concerning this communication should be directed to Sam Rimell at telephone number (571) 272-4084.

A handwritten signature in black ink, appearing to read 'S. Rimell', is positioned above the printed name.

Sam Rimell
Primary Examiner
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